

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAINER H. WISCHINSKI

Appeal 2007-0894
Application 09/635,280
Technology Center 2100

Decided: June 18, 2007

Before LEE E. BARRETT, MAHSHID D. SAADAT, and ALLEN R. MACDONALD, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-17, 19-21, and 23. Claims 18 and 22 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to a control system on a network which includes an automation device and a network device. One of the plurality of

application programs stored in the network device controls the automation device and is selected by the network device in response to an application program request sent from the automation device (Specification 2).

Independent Claim 1 is exemplary and reads as follows:

1. A control system, comprising:

an automation device operably connected to a network;

a network device operably connected to the network; and,

a plurality of customized application programs for the automation device stored in the network device, wherein one customized application program of the plurality of customized application programs controls the automation device, and is selected by the network device in response to a specific application program request message for the one customized application program received at the network device and sent from the automation device as part of a bootstrap protocol, and wherein the customized application program is downloaded to the automation device at a boot time of the automation device.

The Examiner relies on the following prior art in rejecting the claims:

Nookala	US 5,878,257	Mar. 2, 1999
Nixon	US 5,909,368	Jun. 1, 1999
Johnson	US 6,788,980 B1	Sep. 7, 2004
		(effectively filed Aug. 17, 1999)

Ditze, “*A Customizable Library to support Software Synthesis for Embedded Applications and Micro-Kernel Systems*”, September 1998, pp. 88-95.

Claims 1, 2, 4-9, 11-13, 15, 17, 19-21, and 23 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Nixon and Nookala.

Claims 3, 14, and 16 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Nixon, Nookala and Ditze.

Claim 10 stands rejected as being unpatentable under 35 U.S.C. § 103(a) over Nixon, Nookala, and Johnson.

Rather than repeat the arguments here, we make reference to the Briefs and the Answer for the respective positions of the Appellant and the Examiner.

We reverse.

ISSUE

Appellant contends that, instead of the automation device, it is the user in Nixon who selects a control routine to be downloaded (Br. 11). The Examiner argues that the user in Nixon creates a customized program which defines the programs to be downloaded (Answer 16-18). Therefore, the issue on appeal turns on whether a preponderance of the evidence before us shows that the combination of the prior art teaches or suggests the claimed subject matter and specifically the customized application program in response to a specific application program request received at the network device and sent from the automation device.

FINDINGS OF FACT

Nixon relates to a process control system using a distributed process control strategy (col. 2, ll. 8-10) wherein a user defines the control strategy by building a plurality of function blocks and control modules and downloading or installing user-specified portions of the control strategy to be downloaded (col. 4, ll. 45-51).

The customized program of Nixon relied on by the Examiner is actually various control routines generated in response to user input

commands (col. 7, ll. 8-13). The user designs the control routines by creating control templates which are defined as the grouping of attribute functions that are used to control a process and the related control methodology (col. 9, l. 62-67). However, Nixon does not provide any teachings related to the selection of the application program in response to a message from any element other than the user.

Nookala provides for programs that allow firmware to be dynamically written into programmable memory from a remote location (col. 2, ll. 6-9).

Nookala further discloses that a request is sent to the data source to initiate the transmission of the program's instruction codes for retrieving the program used in writing a firmware into a storage device from a source connected to the network (col. 3, ll. 21-27, 43-45). However, there is no disclosure in Nookala describing that the request is received at the network device and sent from the automation device.

PRINCIPLES OF LAW

A claimed invention is unpatentable as obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *See* 35 U.S.C. § 103(a) (2002); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999).

While "the common sense of those skilled in the art" may be relevant to an obviousness inquiry, *cf. Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1690 (Fed. Cir. 2007), the

ultimate consideration depends on “the differences between the subject matter sought to be patented and the prior art” and the level of “ordinary skill in the art.” *See* 35 U.S.C. 103(a) (2002). Thus, a determination of obviousness requires us to:

- 1) determine the scope and content of the prior art;
 - 2) ascertain differences between the prior art and the claims at issue;
- and
- 3) determine the level of ordinary skill in the art. *See Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. “Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.” *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). *See also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

ANALYSIS

The Examiner does not show where the prior art teaches or suggests that the application programs are selected in response to a request message sent from the automation device. While Nixon indicates that control templates define the control process and methodology, no further suggestion as to the source of the request message used for selection of the application programs other than the user can be discerned from the reference.

Similarly, the Examiner’s assertion that Nookala provides for the specific application program request (Answer 19), ignores the specific

recited features of the claim. Nookala's request is for transmission of the codes to retrieve a program used in rewriting the firmware which is different from the claimed request sent from an automation device for a specific application program for the control of the automation device. Thus, we find that the Examiner's rejection rests on speculation and less than a preponderance of the evidence and thus, fails to provide sufficient reasons for finding claim 1, as well as claims 2, 4-9, 11-13, 15, 17, 19-21, and 23 which include similar limitations, unpatentable for obviousness under 35 U.S.C. § 103(a) over Nixon and Nookala.

With respect to the rejection of claims 3, 10, 14, and 16, we note that the Examiner further relies on Ditze and Johnson for the additional features recited in these dependent claims. However, the Examiner does not point to any additional teachings or convincing rationale in modifying the combination of Nixon and Nookala with the teachings of these references that would have overcome the deficiencies of the applied prior art as discussed above with respect to claim 1. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 3, 14, and 16 over Nixon and Nookala in combination with Ditze, nor of claim 10 over Nixon and Nookala in combination with Johnson.

Appeal 2007-0894
Application 09/635,280

DECISION

The decision of the Examiner rejecting claims 1-17, 19-21, and 23 under 35 U.S.C. § 103 is reversed.

REVERSED

KIS

SCHNEIDER ELECTRIC / SQUARE D COMPANY
LEGAL DEPT. - I.P. GROUP
1415 S. ROSELLE ROAD
PALATINE, IL 60067